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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,521	07/11/2003	Thomas F. Calton	40682/298	5072
33642 7590 03/19/2009 STOEL RIVES LLP - SLC 201 SOUTH MAIN STREET, SUITE 1100 ONE UTAH CENTER SALT LAKE CITY, UT 84111				
EXAMINER				
SWIGER III, JAMES L				
ART UNIT		PAPER NUMBER		
3775				
MAIL DATE		DELIVERY MODE		
03/19/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/618,521

Applicant(s)

CALTON ET AL.

Examiner

JAMES L. SWIGER

Art Unit

3775

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 4/13/2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-37 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claim 1, applicant claims that "at least a portion of a first member is anchored to bone." Concerning applicant's disclosure, it appears that the first member, also known as the support member #40, does not appear to contact the bone at all in any of the drawings. In paragraph 81 of applicant's specification, support is found for only "a portion of device 10" being anchored to bone. In claim 1 previously, a first member was "configured to be anchored to the bone." This is considered a functional limitation and requires only the ability to do so, so positive attachment to bone was not disclosed. In originally filed claim 3, applicant claimed that the "first member is anchored to bone by the at least one securing member." This again does not support that a first member would be anchored to bone, as it is being done so indirectly by the at least one securing member. Therefore applicant has not provided support that a first member is positively anchored to bone, as claim 1 now states.

Claim Rejections - 35 USC § 102

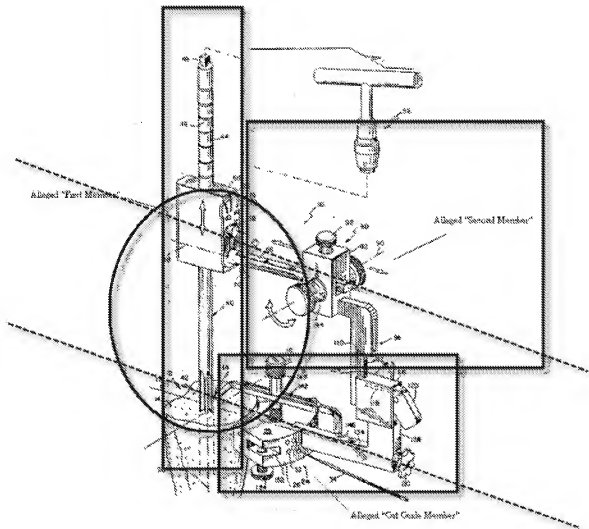
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 4-6, 11, 25-26, 29, 32, 34, 35-37 are rejected under 35 U.S.C. 102(b) as being anticipated by Bowman et al. (US Patent 4,952,213). Bowman et al. ("Bowman") disclose an orthopedic cutting guide device (see entire Fig. 1, and see annotated drawing below) comprising a first member (entire section on left which has a pivot axis extending along the length defined by the body of the first member, extending from 48 to approx bottom at 42), a second member (L-shaped section extending to the right and down), a cut guide (24) releasably secured directly to the second member, and wherein the first member is positioned between a cut guide and the second member (to further clarify, two dotted lines have been drawn to denote exemplary bounds of a cut guide portion and a second member; the oval area represents what portion of the first member is positioned between the cut guide member and the second member), and further wherein the cut guide and second member are able to move together and pivot about the axis of the first member (see arrows 70, this can be a pivot of a first member which the 2nd member and cut guides can move together around). As the cut guide is adjustable, the second member may be selectively released from the first member. The cut guide member is also capable of independent movement from the second member, as they are adjustable with respect to one another and the first member. It is also noted

that the device is configured to be selectively adjusted in both a rotational and translational manner while at least a portion of the device is anchored. Note the arrows in the device denoting various types of movement. See drawing below.



With regards to intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Bowman et al. which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the

law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Bowman further discloses an orthopedic cutting guide device that has at least one securing member (34) and a boom (142) that fits into an opening of the cutting guide (Fig. 1, inserted into top opening). The cutting guide also has various surfaces to assist in guiding a tool, the first member has various surfaces such as a first and second side, also has a tapering(ed) portion (42) which extends from a point on the first member. The cutting guide portions also have various holes.

Response to Arguments

Applicant's arguments filed 12/2/2008 have been fully considered but they are not persuasive. In regards to the 112-1st rejection, the "device" not being necessarily part of the "first member" was intended to point out that in line 3 of claim 1, the bone is addressed in a functional sense, while the device was positively anchored to a body part, which was considered structure. The comparison was meant to draw attention to the difference. In regards to Bowman, a drawing has been included and the rejection clarified. In regards to dependent elements in the claims, certain arguments were found persuasive while others are now objected to.

Allowable Subject Matter

Claims 7-10, 12-24, 27-28, 30-31, 33 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **JAMES L. SWIGER** whose telephone number is (571)272-5557. The examiner can normally be reached on **M-F, 9am-5:30pm**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JAMES L. SWIGER/
Examiner, Art Unit 3775

/Eduardo C. Robert/
Supervisory Patent Examiner, Art Unit 3733